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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/868,801	06/21/2001	David Robert Fenn	OC-529	5080

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PPG INDUSTRIES INC
INTELLECTUAL PROPERTY DEPT
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EXAMINER

SERGEANT, RABON A

ART UNIT	PAPER NUMBER
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1711

DATE MAILED: 09/16/2002

10

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.
09/868,801

Applicant(s)
Fenn et al.

Examiner
Rabon Sergeant

Art Unit
1711



-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE three MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on Jun 14, 2002
- 2a) ☒ This action is FINAL. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1, 2, 4, and 6-11 is/are pending in the application.
- 4a) Of the above, claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1, 2, 4, and 6-11 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claims _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- *See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s). 9 6) ☐ Other: _____

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1. Claims 1, 2, 4, and 6-11 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Applicants have specified that the coating composition is liquid; however, applicants have failed to specify the conditions at which the composition is liquid. Furthermore, with respect to claim 10, it is unclear how to interpret the requirement that the composition be liquid and the optional requirement that the composition be dissolved in a solvent.

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor

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and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

3. Claims 1, 2, 4, and 6-11 are rejected under 35 U.S.C. 102(b) as being anticipated by WO 97/30099 or NL 9201868.

The references disclose the production of coatings, wherein diphenylmethane diisocyanate is reacted with a polyester corresponding to the instantly claimed polyester. See entire documents. The examiner has considered applicants' "no reactive diluent" language; however, it is noted that WO 97/30099 provides for diluents having amine groups which are considered to be outside the instantly claimed species of the diluent. Furthermore, claim 10 is not limited with respect to the diluent. With respect to applicants' argument that the composition of NL 9201868 is in the form of a binder for powder paints, the position is taken in the absence of a temperature condition for the instantly claimed liquid composition, that the liquid requirement is met when the binder is heated and melted.

4. Claims 1, 2, 4, and 6-11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Chattha ('906) or Peng et al. ('508) or WO 96/20968, each in view of WO 97/30099.

The primary references disclose coating compositions derived from the reaction of a polyisocyanate crosslinking agent with a polyester containing secondary hydroxyl groups, derived from the reaction of compounds containing carboxyl groups with epoxides.

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5. While the references teach the use of epoxides to produce the secondary group containing polyesters, the references are silent regarding the use of applicants' claimed glycidyl ester of C₁₁-C₂₀ alkanolic acid as the epoxide. However, the use of such epoxides to produce secondary group containing polyesters for use within isocyanate cured coating compositions was known at the time of invention. This position is supported by the teachings of WO 97/30099 at page 6, lines 35-37.

6. Therefore, the position is taken that it would have been obvious to utilize the claimed epoxide within the primary references, so as to arrive at the instant invention, because it has been held that it is obvious to utilize a component for its known function. In re Linder, 173 USPQ 356. In re Dial et al., 140 USPQ 244. One would have reasonably expected the use of the claimed epoxides to yield compositions having properties analogous to the properties of the compositions of the primary references.

7. The examiner has considered applicants' amendment, wherein the transitional phrase, "consisting essentially of", has been incorporated into claims 1 and 11; however, applicants have failed to establish that the argued additional components of the references would have a material effect on the compositions and would therefore be excluded from the claims. It is noted that claim 10 has not been amended to include the aforementioned transitional phrase.

8. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

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A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication should be directed to R. Sergent at telephone number (703) 308-2982.


RABON SERGENT
PRIMARY EXAMINER

R. Sergent
September 12, 2002